

REMARKS

In the Office Action mailed November 28, 2007, the Examiner noted that claims 1-3, 6-9, 12-15, 18, 19 and 22 were pending and rejected claims 1-3, 6-9, 12-15, 18, 19 and 22. No claims have been amended, no claims have been canceled, new claim 23 has been added; and, thus, in view of the foregoing claims 1-3, 6-9, 12-15, 18, 19, 22 and 23 remain pending for reconsideration which is requested. No new matter is believed to have been added. The Examiner's rejections are respectfully traversed below.

Rejections under 35 U.S.C. § 103

At item 3 on page 2 of the Office Action, claims 1-3, 6-9, 12-15, 18, 19 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Valentino (U.S. Patent No. 4,648,037) in view of Kramer et al. (U.S. Patent No. 6,327,574).

Valentino is related to a method and apparatus for a benefit and a financial communication system that enables an employee to access information by a terminal concerning their up to date savings plans and the values thereof (see Valentino, Abstract).

Kramer et al. is related to hierarchical models of consumer attributes for targeting content in a privacy-preserving manner (see Kramer et al., Abstract). Particularly, Kramer et al. describes logically controlling consumer profiles by the consumer's computer, thereby, providing for enhanced security over information that is personal and confidential to the consumer (see Kramer et al., Abstract, col. 11, lines 60-62).

In claim 1, however, the information inquiry apparatus comprises of "a product promotion analyzer that computes a product promotion result of advertisement on the basis of an output of the purchase simulator and sends the product promotion result of more than one member in aggregate to the advertising company such that privacy is ensured for the more than one member".

By at least the above-mentioned features in claim 1, by computing a product promotion result of advertisement on the basis of an output of the purchase simulator and sending the product promotion result to the advertising company, privacy and access to other sensitive information issues are addressed.

In Kramer et al. all processing (e.g. interpretations and selections) takes place on the clients system (e.g. user system). Further, the server system only provides information requested by the client (e.g. user). In claim 1, the product promotion analyzer is located in the information inquiry apparatus, which is separate from the user terminal. Therefore, Kramer et al. does not teach or suggest such a feature as recited in claim 1.

Further, the Office Action, on pages 3 and 4, asserted that any structured document may be illuminated with advertisements. On page 14, the Response to Argument section of the Office Action again asserted that the advertisements of Kramer et al. "can be applied to any type of structured document so long as it is formatted with the information describing the selectable content alternatives, in accordance with the present invention, including any type of financial statement generally (e.g. bank statements or stock portfolio statements).

However, it is respectfully submitted that Office Actions assertion that the advertisements described in Kramer et al. can be applied to any type of structured document and any type of financial statement generally is not enabling. Any reference used to reject a claim must itself be enabling for the subject matter of the invention alleged to be taught (see In re Wilder, 429 F.2d 447, 166 U.S.P.Q. 545 (C.C.P.A. 1970) and In Re Collins, 462 F.2d 538, 174 U.S.P.Q. 333 (C.C.P.A. 1972)). Stated another way, for the prior art to be enabling the prior art must teach how to produce the feature of the claimed invention.

Further, such an assertion by the Office Action constitutes improper hindsight because the Office Action failed to take into account the knowledge of a person having ordinary skill in the art at the time the invention was made. (see MPEP 2142 and 2145). The Office Action does not base the rejection on facts gleaned from Kramer et al., rather bases the rejection on mere conclusory statements that are not supported by facts that would teach or even suggest one of ordinary skill in the art to reproduce such features as recited in claim 1.

Kramer et al. does not teach or suggest how to produce "an advertisement information file that stores advertising information ... including an advertisement link that allows access to an additional advertising information ... sent from an advertising company." Rather, Kramer et al. describes **replacing** a static text with a graphic icon (e.g. illumination) on the credit card statement, which appears on the consumer's computer. (See Kramer et al., col. 6, lines60-65).

Further, on page 15, the Office Action asserted that Valentino discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans and asserted that these choices are advertisement used to entice employees to purchase the displayed product. However, the above-mentioned assertion is not enabling since Valentino does not teach or suggest how to produce the features of the claimed invention.

In addition, the above-mentioned assertion by the Office Action merely speculates that Valentino teaches "a purchase simulator that simulates the member's purchase of the advertising company's product using a simulation database containing products and product prices of the advertising company" as recited in claim 1. Particularly, the Office Action merely speculates that "what if" scenario equates to the claimed "purchase simulator". This speculation

is incorrect since the Valentino fails to teach or suggest how the above-mentioned recitation in claim 1 constitutes "generating what if scenarios". Therefore, the alleged disclosure is not enabling since Valentino describes that an employee can enter personalized information which can be treated independently or associated/merged with the data already in the extract to provide a new and more extended view of information. (See Valentino, col. 14, lines 45-57). As a result, the employee can examine different financial conditions in a manner that is not readily available without extensive mathematic calculations. Stated another way, Valentino describes a situation that informs that employee of different situations.

However, in claim 1, the purchase simulator simulates the member's purchases of the advertising company's product using a simulation database containing product and product prices of advertising company. Further, in claim 1, based on the purchase simulator the product promotion result is **computed and sent** to the advertising company. In Valentino, on the other hand, the "what if" scenarios are presented to the consumer so the consumer can make a more sound decision. Therefore, Valentino does not teach or suggest how to produce the above-mentioned features of claim 1.

On page 16, the Office Action states that Applicant's amendment requires that the purchase simulator uses a simulation database containing products and product prices of the advertising company. (see Office Action, page 16, item 4d). The Office Action further states that Valentino teaches such a feature. However, as discussed above, in claim 1 based on the purchase simulator simulating the member's purchase of the advertising company's product, "the product promotion analyzer computes a product promotion result of advertisement and sends the product promotion result ... to the advertising company." Valentino describes the opposite, in that the "what if" scenarios are not presented to the advertising company rather the "what if" scenarios are presented to the employee.

Therefore, based upon the above-mentioned discussion, it is respectfully submitted that claim 1 is patentable over Valentino and Kramer et al., taken alone or in combination thereof.

Claims 7, 13, 19 and 22 emphasize similar features as claim 1. Therefore, it is respectfully submitted that claims 7, 13, 19 and 22 are patentable over the references, take alone or in combination thereof, for at least the same reasons

Further, the dependent claims are patentable over the cited references, take alone or in combination thereof, for the same reasons as their respective base claims.

New Claim

New Claim 23 has been added to emphasize the feature of "providing the employee, by an employee information apparatus, with advertisements based upon the employee information"

which is not disclosed, either expressly or implicitly, by the cited references. Support for new claim 23 can be found at paragraph [0033] of the Specification. Therefore, it is submitted that new claim 23 is patentable over the cited references, taken alone or in combination.

Summary

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

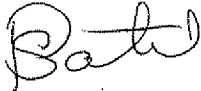
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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